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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MEREK, JOSEPH C

ART UNIT PAPER NUMBER

3727

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,841

Applicant(s)

HERRERA, RAY

Examiner

Joseph C. Merek

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 and 19-34 is/are pending in the application.
- 4a) Of the above claim(s) 25-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Newly submitted claims 26-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 26-27 are directed to a method of storing a key. The originally filed claims were directed to a method of making a key storage device or a key storage device. The key storage device could be used in a method of storing money or something other than a key. The method of making and the method of storing are not related. Claims 28-34 are directed to a method of making an article storage device. Applicant has included limitations to the use of the article one the article is made. These should be methods of using the article storage device. Moreover, applicant is trying to cross statutory boundaries and include steps of use in the method of making. The method of making the product and the method of using a product are different and separate inventions. Since the claims include use steps they claims are interpreted as methods of use.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3727

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 13, it has not been adequately disclosed that as the process of producing the key storage device includes arranging the body so that the slot opening is generally facing downward. This is a new matter rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 19, 20, 23, 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dreher (US 3,308,726) in view of Kim et al (US 6,638,152).

Regarding claim 12, Dreher teaches making the groove by employing a saw cutting process and that the groove is formed in concrete but does not teach that the terminal side of the slot is generally arcuate. Kim et al teaches cutting with a circular rotating blade. It would have been obvious to employ the circular blade of Kim et al in the process of Dreher to provide a rapid cutting process. The circular blade will make the terminal end of the slot generally arcuate at the ends due to the circular blade. See Dreher, Col. 5, line 54 where the cuts are saw slotted. See Figs. 9 and 10 where the closure strip is shown. The saw cuts are made by a circular blade, which makes the

Art Unit: 3727

terminal side generally actuate at the ends of the cuts. See Col. 5, lines 62 where the closure strip may be lubricated with a fugitive substance that would all for the removal of the closure strip. The material is concrete. Regarding claim 13, the downward facing opening is a matter of orientation. The upper surface is substantially smooth and the limitation that the underside does not require any structure that is not in the combination of references. Underside is a matter of orientation. Regarding claim 15, the strip is a pliable material as seen in Figs. 9-11. Regarding claims 14 and 24, Dreher does not teaches a hard material for the body but does not teach the natural hard rock. Kim et al teach cutting or grinding in concrete as well as natural hard rock, i.e. granite. It would have been obvious to employ the natural hard rock of Kim et al in the body of Dreher to provide a more visually appealing material. Regarding claims 19, 20, and 23, Dreher does not teach that cutting the slot comprises grinding or the circular rotating grinder blade. Kim et al teach an abrasive circular rotating blade for cutting or grinding slots in concrete or natural stone. It would have been obvious to employ the grinding and circular blade for cutting the slot of Dreher as they are both suited to the specific task as taught by Kim et al. Moreover, since the blades for cutting the stone or concrete material are abrasive, the cutting is a grinding action. The blade will inherently be advanced to a specified depth to create the required depth shown in the Figures of Dreher.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dreher in view of Kim et al as applied to claim 20 above, and further in view of Samsom et al (US 5,168,583). Regarding claims 21 and 22, the modified method of

Art Unit: 3727

Dreher does not teach the depth is between $\frac{1}{2}$ to 2 inches. Samsom et al, Col., 3, lines 13-21, teaches a similar process where the slot is cut to a depth of a minimum of 30 mm. It would have been obvious to employ the depth of Samsom et al in the modified process of Dreher to provide an adequate depth for the closure strip and to provide an adequate expansion joint. This 30 mm depth falls within the specified ranges. 30 mm is between 1 and 1.5 inches. The slot is capable of holding a key. There exist keys of many sizes including those that are very small. See Fig. 10 of Dreher where a compartment remains between the terminal side of the slot and the closure strip.

Response to Arguments

Applicant's arguments with respect to claims 12-15, and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

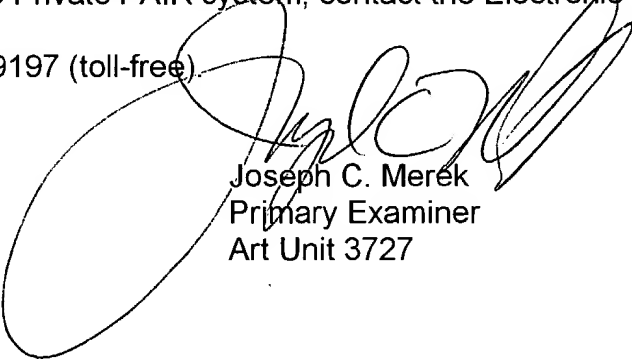
Art Unit: 3727

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is 571 272-4542. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (571) 272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merek
Primary Examiner
Art Unit 3727